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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/312,922	05/17/1999	DR. VINCENT MICHAEL FIGUREDOR	ICOM-00401	3206

7590 12/17/2003

KENDYL ROMAN
730 BANTRY COURT
SUNNYVALE, CA 94087-3402

EXAMINER

PARSONS, CHARLES E

ART UNIT	PAPER NUMBER
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2613

16

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/312,922

Applicant(s)

FIGURED ET AL. 1

Examiner

Charles E Parsons

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 23-27 and 32-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2613

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/02/2003 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., transmission of live video) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The independent claims say nothing about the transmission of live video. Only the dependent claims mention it. Furthermore Wood clearly teaches that while his system does predate current video feed technology, he does anticipate the allowance for transmitting video images via the video processor mentioned in column 3 lines 6-9. The Examiner also points out that it was well known at the time the invention was made that video is simply a series of still images shown in succession giving the perception of motion. Furthermore, Woods system is meant for remote diagnostics by physicians in real time, thus live and he again mentions video in column 11 lines 59-63..

The claims only require a compression engine and transmitting the data representative of the video image. No specifics are claimed as to the type of compression engine used. Furthermore JPEG is the precursor to MPEG. MPEG predates Woods filing date, had it been available to him it would have made sense for him to use it. Therefore, simply updating the prior art is not patentable. As mentioned above Woods does teach the capability of transmitting video images, he also teaches the benefits of compressing the data. Thus a person of ordinary skill in the art would of at the very least found it obvious to update and use MPEG. Furthermore there are no specifics about the decompression engine used in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2613

The Examiner stands behind the 35 U.S.C 112 rejection. The same compressor is used for both the lossy and lossless compression algorithms thus its only one compression engine not a plurality of them.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-7, 23-27, 33, 34, and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by Wood et al.

Claim 1, 23, 33: A system for transmitting data representing a video image, comprising:

- a. a medical test device for generating the video image; (See Wood figure 1 items 12 and 20.)
- b. a transmitter coupled to the medical test device for receiving and selectively distributing data representing the video image; and (See Wood figure 1 item 32 a modem is a transmitter.)
- c. one or more remote receivers for communicating with the transmitter and configured to receive the data representing the video image from the transmitter. (See Wood abstract) claim 23 is further limited to remote control of the device, (See Abstract)

Claim 2. The system according to claim 1 wherein the transmitter further comprises a compressor configured for compressing the data representing the video image. thereby forming a compressed stream of data. (See Wood column 10 lines 7-9)

Claim 3: The system according to claim 2 wherein the one or more receivers further comprise a decompressor configured for returning the compressed stream of data into an

Art Unit: 2613

uncompressed state. (See Wood column 10 lines 7-9 if data is compressed when transmitted, a decompressor on the receiving side is inherent.)

Claim 4: The system according to claim 1 further comprising a recorder device coupled to the medical test device and configured for storing the data representing the video image generated by the medical test device. (See column 12 line 63 through column 13 line 5)

Claim 5, 24: The system according to claim 1 wherein the medical test device is one of an ultrasound, a sonogram, an echocardiogram, and an angioplastigram. (See Wood abstract)

Claim 6, 25: The system according to claim 1 further comprising a network coupled between the transmitter and the one or more receivers for transporting the data representing the video image. (See Wood abstract.)

Claim 7, 26: The system according to claim 6 wherein the network is an Internet Protocol network. (See Wood columns 5 and 6.)

Claim 27, 34: The system according to claim 23 wherein the user remotely controls parameters of the plurality of video images including frame rate and frame size. (See column 10 lines 10-39)

Claim 36. A system of claim 33 wherein said control command allows the remote user to start or stop the transmission of said video. See column 11, starting and stopping transmission of images is an inherent feature.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Wood.

Claim 32. The system of claim 23, said system further comprising:

d. a robotic device coupled to said transmitter, wherein said transmitter is configured to control said robotic device, and wherein said transmitter is configured to receive control commands from said user, and wherein at least one of said video images comprises a substantially live video, whereby said remote receiver receives and displays said live video substantially in real time, and whereby the remote user can control said robotic device with control commands while viewing said live video. See Wood column 11 lines 35-59 wherein Wood teaches that his system is capable of controlling the system remotely. While he does say that he needs a pair of hands at the patient location, it is clear that the hands are not those of the physician. Thus the physician remotely controls the imaging device. The use of a robotic device is interpreted as making the system automatic thus not needing a second person. However, case law has previously settled that "it is not invention to broadly provide a mechanical or automatic means to replace manual activity which can accomplish the same result" In re Rundell, 18 CCPA 1290, 48 f.2d 958, 9 USPQ 220. In this case a robotic arm would accomplish the same result as that of a person.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2613

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 35 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no mention of a single transmitter containing a plurality of video compressors in the specification. Thus a selection between a plurality of compressors by the remote user is impossible within the scope of the current invention. An introduction of a transmitter containing multiple compressors would constitute the addition of new matter into the specification. For this new matter to be entered, the Applicant must file a CIP of the current application.

Claim 35. A system of claim 33 wherein the transmitter further comprises a plurality of video compressors and, wherein said control command allows the remote user to select or change the selection of one of the plurality of video compressors to be used by the transmitter to process said digitized frames.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Art Unit: 2613

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E Parsons whose telephone number is 703-305-3862. The examiner can normally be reached on M-TH 7AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 703-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

CEP


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
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